

REMARKS

I. Introduction

Claims 1 to 8 and 10 to 15 are pending in the present application. In view of the following remarks, it is respectfully submitted that all of the presently pending claims are allowable, and reconsideration is respectfully requested.

II. Rejection of Claims 1 to 8, 10, 13 to 15 Under 35 U.S.C. § 102(b)

Claims 1 to 8, 10, 13 to 15 were rejected under 35 U.S.C. § 102(b) as anticipated by U.S. Patent No. 4,897,360 ("Guckel et al."). Applicants respectfully submit that Guckel et al. do not anticipate the present claims for the following reasons.

Claim 1 relates to a micromechanical component. Claim 1 recites a supporting body, at least one at least partially unsupported membrane connected to the supporting body; and at least one stabilizing element provided in an unsupported area on some areas of a surface of the at least one membrane, wherein the at least one membrane extends continuous over an entire recess etched in the supporting body. Claim 1 also recites that a portion of the at least one stabilizing element contacts only the membrane for a part less than a whole length of the recess of the membrane and a portion of the at least one stabilizing element is positioned between the supporting body and the at least one membrane. Claim 1 has been amended herein without prejudice to recite that at least a part of the stabilizing element is exposed to the recess etched in the supporting body. Support for the amendment to claim 1 may be found, for example, in Figures 2, 3b and 6b.

Guckel et al. allegedly relate to a polysilicon thin film process. The Office Action relies on Figure 31 for the rejection of claims 1 to 8, 10, and 13 to 15. A silicon nitride layer 87 is placed over a polysilicon layer 83. A silicon nitride layer 81 is placed below the polysilicon layer 83. The Office Action alleges that the supporting body of the present claims is provided by the base wafer 80. The Office Action further alleges that the polysilicon layer 83 corresponds to the stabilizing element of the current claims. The Office Action still further alleges that the membrane of the current claims is provided by the silicon nitride layer 87. Applicants respectfully submit that Guckel et al. do not disclose or suggest of at least a part of a stabilizing element is exposed to a recess etched in a supporting body. As an initial matter, as illustrated in Figure 31, the silicon nitride layer 87 does

not fully extend over the gaps defined by element 80, therefore Applicants respectfully submit that the silicon nitride layer 87 does not provide the required membrane in claim 1. Applicants further submit that if the combination of the silicon nitride layer 87 and the silicon nitride layer 81 is alleged to be equated to the membrane provided in claim 1, then Guckel et al. do not disclose or suggest any configuration in which a stabilizing element is exposed to a recess etched in a supporting body. As provided in Figure 31, the polysilicon layer 83 is sandwiched between the silicon nitride layer 87 and the additional silicon nitride layer 81. Thus, a stabilizing element, therefore, is not directly exposed to a recess etched in a supporting body.

To anticipate a claim, each and every element as set forth in the claim must be found in a single prior art reference. Verdegaal Bros. v. Union Oil Co. of Calif., 814 F.2d 628, 631, 2 U.S.P.Q.2d 1051, 1053 (Fed. Cir. 1987). Furthermore, “[t]he identical invention must be shown in as complete detail as is contained in the . . . claim.” Richardson v. Suzuki Motor Co., 868 F.2d 1226, 1236, 9 U.S.P.Q.2d 1913, 1920 (Fed. Cir. 1989). That is, the prior art must describe the elements arranged as required by the claims. In re Bond, 910 F.2d 831, 15 U.S.P.Q.2d 1566 (Fed. Cir. 1990). As more fully set forth above, it is respectfully submitted that Guckel et al. do not disclose, or even suggest, all of the limitations of claim 1, including at least a part of a stabilizing element exposed to a recess etched in a supporting body. It is therefore respectfully submitted that Guckel et al. do not anticipate amended claim 1.

As for claims 2 to 8, 10, and 13 to 15, which ultimately depend from claim 1 and therefore include all of the limitations of claim 1, it is respectfully submitted that Guckel et al. do not anticipate these dependent claims for at least the same reasons given above in support of the patentability of amended claim 1.

III. Rejection of Claims 11 and 12 Under 35 U.S.C. § 103(a)

Claims 11 and 12 were rejected under 35 U.S.C. § 103(a) as unpatentable over Guckel et al. Applicants respectfully submit that Guckel et al. do not render obvious claims 11 and 12 for the following reasons.

Claims 11 and 12 depend from claim 1 and therefore include all of the limitations of claim 1. As discussed above, Applicants respectfully submit that

Guckel et al. do not disclose or suggest at least the feature that at least a part of a stabilizing element is exposed to a recess etched in a supporting body.

In rejecting a claim under 35 U.S.C. § 103(a), the Examiner bears the initial burden of presenting a prima facie case of obviousness. In re Rijckaert, 9 F.3d 1531, 1532, 28 U.S.P.Q.2d 1955, 1956 (Fed. Cir. 1993). To establish prima facie obviousness, three criteria must be satisfied. First, there must be some suggestion or motivation to modify or combine reference teachings. In re Fine, 837 F.2d 1071, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988). This teaching or suggestion to make the claimed combination must be found in the prior art and not based on the application disclosure. In re Vaeck, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991). Second, there must be a reasonable expectation of success. In re Merck & Co., Inc., 800 F.2d 1091, 231 U.S.P.Q. 375 (Fed. Cir. 1986). Third, the prior art reference(s) must teach or suggest all of the claim limitations. In re Royka, 490 F.2d 981, 180 U.S.P.Q. 580 (C.C.P.A. 1974). As more fully set forth above, Guckel et al. do not disclose, or even suggest, all of the claim limitations of claim 1, from which claims 11 and 12 ultimately depend, including the limitation that at least a part of a stabilizing element is exposed to a recess etched in a supporting body. It is therefore respectfully submitted that Guckel et al. do not render unpatentable claims 11 and 12, which ultimately depend from claim 1.

Moreover, it is respectfully submitted that the cases of In re Fine, supra, and In re Jones, 21 U.S.P.Q.2d 1941 (Fed. Cir. 1992), make plain that the Office Action's generalized assertion, i.e., that it would have been obvious to modify or combine the reference, do not properly support a § 103 rejection. It is respectfully submitted that the above-cited cases make plain that the subjective "obvious to try" standard reflected in the present Office Action is improper, and that the Examiner has failed to provide proper evidence to support an obviousness rejection based on the reference relied upon. In particular, the Court noted in the case of In re Fine:

The PTO has the burden under section 103 to establish a *prima facie* case of obviousness. It can satisfy this burden only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references. This it has not done. . . .

Instead, the Examiner lies on hindsight in reaching his obviousness determination. . . . One cannot use hindsight reconstruction to pick and choose among isolated

disclosures in the prior art to deprecate the claimed invention.

In re Fine, 5 U.S.P.Q.2d at 1598-1600. Likewise, the Court noted in the case of In re Jones:

Before the PTO may combine the disclosures of two or more prior art references in order to establish *prima facie* obviousness, there must be some suggestion for doing so, found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. . . .

Conspicuously missing from this record is any evidence, other than the PTO's speculation (if it be called evidence) that one of ordinary skill . . . would have been motivated to make the modifications . . . necessary to arrive at the claimed [invention].

In re Jones, 21 U.S.P.Q.2d at 1943, 1944.

It is respectfully submitted that the present Office Action offers no objective evidence whatsoever to support the obviousness conclusion, but only conclusory hindsight, reconstruction and speculation, which the above-noted cases have indicated as failing to constitute evidence that will support a proper obviousness finding.

More recently, the Federal Circuit in the case of In re Kotzab has made plain that even if a claim concerns a "technologically simple concept" -- which is not the case here -- there still must be some finding as to the "specific understanding or principle within the knowledge of a skilled artisan" that would motivate a person having no knowledge of the claimed subject matter to "make the combination in the manner claimed":

In this case, the Examiner and the Board fell into the hindsight trap. The idea of a single sensor controlling multiple valves, as opposed to multiple sensors controlling multiple valves, is a technologically simple concept. With this simple concept in mind, the Patent and Trademark Office found prior art statements that in the abstract appeared to suggest the claimed limitation. But, there was no finding as to the specific understanding or principle within the knowledge of a skilled artisan that would have motivated one with no knowledge of Kotzab's invention to make the combination in the manner claimed. In light of our holding of the absence of a motivation to combine the teachings in Evans, we conclude that the Board did not make out a proper *prima facie* case of obviousness in

rejecting [the] claims . . . under 35 U.S.C. Section 103(a) over Evans.

In re Kotzab, 55 U.S.P.Q.2d 1313, 1318 (Fed. Cir. 2000) (emphasis added). Again, it is believed that there have been no such findings with regard to the present application.

Accordingly, there is no evidence that the reference relied upon, would provide the necessary suggestion to achieve the subject matter recited in claims 11 and 12, which ultimately depend from claim 1.

IV. Conclusion

It is therefore respectfully submitted that all pending claims are allowable. All issues raised by the Examiner having been addressed, an early and favorable action on the merits is earnestly solicited.

Respectfully submitted,

KENYON & KENYON

Dated: May 14, 2004

By:

R. L. Mayer
Richard L. Mayer
Reg. No. 22,490

Rev. 42,194

One Broadway
New York, New York 10004
(212) 425-7200

CUSTOMER NO. 26646